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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------------|
| 09/785,929 | 02/16/2001 | Srihari Kumar | P3961 | 4318 |
| 24739 7590 05/07/2007 CENTRAL COAST PATENT AGENCY, INC 3 HANGAR WAY SUITE D WATSONVILLE, CA 95076 | | | EXAMINER GREENE, DANIEL LAWSON | |
| | | | ART UNIT 3694 | PAPER NUMBER |
| | | | MAIL DATE 05/07/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/785,929

Applicant(s)

KUMAR ET AL.

Examiner

Daniel L. Greene Jr.

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Detailed Action

1. Claims 13-23 are currently pending. Claims 1-12 and 24-34 were previously cancelled. Claims 13, 15, 16, 21-23 have been amended in the response received 11/06/2006. An action on the merits of claims 13-23 follows.
2. Please note that the Examiner of record has changed. Please address all further correspondence to Examiner Greene.

Response to amendments

3. Applicant's amendments to the Abstract, Specification, Drawings and Claims appear to have overcome the objections and rejections set forth in sections 2-5 of the previous Office action mailed 3/23/2006. Accordingly the objections and rejections of said sections are hereby withdrawn.

Claim Objections

4. Claim 15 is objected to as it contains improper verbiage. Currently the claim reads "providing a personalized interfaces..." It appears that the word "a" is unnecessary. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. There is no proper antecedent basis for all terms present. See for example the remote computer nodes in claim 13, the server in claim 20, etc.

b. Claim 20 is vague, indefinite and incomplete in what all is meant by and encompassed by the phrase "...connected data repository held externally from the server" because the claim fails to set forth what the limitation "externally from" means. That is, the claim fails to set forth whether the data repository (known in the art as nothing more than a hard drive and its functional equivalents) is external to the actual box that the server resides in, or whether it's external to the room that the server is physically situated in, etc. Accordingly the metes and bounds of the claim are undefined.

c. Claim 20 is vague, indefinite and incomplete in what all is meant by and encompassed by the phrase "...connected data repository held externally from the server" because the claim fails to set forth what the limitation "the server" means. That is, the claim fails to set forth exactly which server as there are two servers, the first and second. Accordingly the metes and bounds of the claim are undefined.

d. Claim 22 is vague, indefinite and incomplete in what all is meant by and encompassed by the phrase "a full account of the bill" because the term full account has been given no specific meaning by the current claim language, that

is the claim fails to set forth in a clear and concise manner what exactly a "full account" is. Does the term full account mean that the account can accept no more as it is full or does it mean that each and every piece of information regarding the account is set forth? Since the claim language can be interpreted in multiple ways having different connotations the metes and bounds of the claim are undefined.

e. Claim 23 is vague, indefinite and incomplete in what all is meant by and encompassed by the phrase "obtaining advice regarding selected treatment of the bill includes system recommendations." First "treatment of the bill" lacks antecedent basis, second "system recommendations" has no definite meaning, that is the term "system recommendations" is such a broad term that it could mean that a person must have a Pentium II 900 Megahertz processor and modem, or that the system recommends that the person pay the bill immediately. Since the limitation "system recommendations" is not defined by the claim the metes and bounds of the claim are undefined. Third, the limitation "advice" can be given no specific meaning and as such is vague and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 13-23 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent 5,878,405 to Grant et al. (Grant).

Regarding claim 13, Grant sets forth an interactive bill-payment system for online management, viewing and payment on behalf of a user of itemized bills by proxy over a data-packet-network, comprising:

A first sever node connected to the network. The server node providing a service-access-point for accessing users;

A second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to data sources subscribed to by the user, data procurement and data aggregations on behalf of the accessing users;

A bill-payment software interface installed on the first server node, the interface accessible to the accessing users connected to the data-packet-network, characterized in that users accessing the first server node from the remote computer nodes interact with the bill payment interface for the purpose of viewing, managing and paying bills by proxy using the functions of the first and second server nodes in, for example, the abstract, figures 2, col. 13 line 50-col. 14 line 22, claims

Regarding claim 14, Grant discloses that the data-packet-network is the Internet network in, for example, col. 13 line 50-col. 14 line 22.

Wherein the first server node is a portal server providing personalized interfaces in hypertext markup language.

Regarding claim 15 Grant inherently discloses that the first server node is a portal server providing personalized interfaces in hypertext markup language because as set forth in col.14 lines 8-10 and internet connection is set forth wherein it is understood that internet connectivity is typically communicated with hypertext markup language. Further resort may be had to U.S. Patent 6,078,907 to Lamm col. 2 lines 13-18 to show that the World Wide Web is a collection of networks liked together using files written in Hypertext Mark-up Language. Thus APA inherently uses and discloses such.

The use of a secondary reference in connection with a 35 U.S.C. 102 rejection is proper when the secondary reference is cited to show that the primary reference contains an "enabling disclosure". See MPEP § 2131.01.

Regarding claim 16, Grant discloses that the data sources require a username and password for access to user bill information in Fig 3 BLOCK 535.

Regarding claims 17-19, Grant discloses that the remote computer nodes can be personal computers, cellular phones or hand-held computers with accessibility to the Internet

Regarding claim 20, Grant discloses that the second server node stores aggregated bill data on behalf of the user in a connected data repository held externally from the server in, for example, col. 15 lines 5-19.

Regarding claim 21, Grant inherently discloses that the bill-payment software interface is linked to a plurality of secondary interfaces provided in the form of hypertext markup language because, for example it is known for networks to communicate in such manners and Grant uses a network. Further resort may be had to U.S. Patent 6,078,907 to Lamm col. 2 lines 13-18 to show that the World Wide Web is a collection of networks linked together using files written in Hypertext Mark-up Language. The use of a secondary reference in connection with a 35 U.S.C. 102 rejection is proper when the secondary reference is cited to show that the primary reference contains an "enabling disclosure". See MPEP § 2131.01.

Regarding claim 22, Grant discloses that the management of the listed bills include at least viewing a full account of the bill, marking that the bill has been paid, deleting the bill, and receiving an alert associated with the bill in, for example, Figure 2 and supporting text description.

Regarding claim 23, Grant discloses that obtaining advice regarding selected treatment of the bill includes system recommendations in, for example, Figures 2, 3 and the associated description, col. 34, claim 35, etc.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13-23 are rejected over Applicant's Admitted Prior Art (APA) in view of U.S. Patent 5,920,847 to Kolling et al. (Kolling)

Regarding claim 13, APA sets forth an interactive bill-payment system for online management, viewing and payment on behalf of a user of itemized bills by proxy over a data-packet-network (page 2, lines 17-19 "many people now do their banking, stock, trading, and so forth from the comfort of their own homes via internet access"), comprising:

A first server node connected to the network. The server node providing a service-access-point for accessing users (reads on either the person's own computer, their modem that is accessing the internet OR the Internet Service Provider server used by the customer to access the internet);

A second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to data sources subscribed to by the user, data procurement and data aggregations on behalf of the accessing users

(reads on the server the bank is connected to, or the actual bank computer which has the account (data source subscribed by the user) data procurement (required in order to update the account with an accurate balance) and data aggregations (reads on the accounting software that is continually updating the person's account with up to date account balance information));

A bill-payment software interface installed on the first server node, the interface accessible to the accessing users connected to the data-packet-

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network, characterized in that users accessing the first server node from the remote computer nodes interact with the bill payment interface for the purpose of viewing, managing and paying bills by proxy using the functions of the first and second server nodes ("typically, a user, through subscription, has access to personalized and secure WEB pages...." users "bookmark many WEB pages in a computer cache so that they may quickly find and access...various services." And "it is generally known that much work related to finding WEB pages, logging in with passwords, and the like is required to successfully do business on the WEB"

It appears that applicant may be attempting to claim a system that combines ALL of an individuals accounts, login passwords, bill pay subjects, etc. into one place. It is considered that APA does set forth an aggregation of all of the different WEB sites that an person must use in order to pay bills by, for example using the bookmark function on the web browser as set forth above. Further, the individual brain stores the information required in order to locate the various bill payments required, web sites and passwords. The fact that applicant is trying to put all of the information in one place does not present a patentable invention because applicant is merely automating something that was already being done by hand. Admittedly there is great convenience in combining all of a persons assets and liabilities into one location (known in the art as a portfolio) Resort may be had to case law to show that there is no patentability in doing such and further there is motivation to one of ordinary skill in the art to create

such an invention simply for the benefit of convenience and making things easier and more convenient. Such is evidenced by items that surround us in our everyday living, take for example, automatic doors, escalators, moving sidewalks, microwave ovens, pop top soda cans, etc.

Resort may be had to case law to show that there is no novelty in simply automating a process previously done manually and/or combining a series of steps that were previously done individually.

See *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Smith*, 73 USPQ 394

"If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention",

In re Rundell, 9 USPQ 220

"It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result",

and *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961))

"It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable"

If applicant is of the opinion that the APA does not set forth aggregation of all of an individuals bill paying requirements, the resort may be had to the teachings of Kolling to show that it is known in the bill pay art to provide a system that is capable of interfacing with all of a persons billing needs. See for example,

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the abstract, figures and col. 1, lines 14-37, col. 2 lines 63 through col. 4 line 18, col. 11 line 5 through col. 13, lines 15, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Kolling to APA in order to aggregate all of a persons billing requirements into one location for the purpose and benefit of convenience, to both the person and the billers in standardizing the method in which bills are paid for the additional benefit of saving the billers money by minimizing failures of payment.

Regarding claim 14, APA clearly states that the data-packet-network is the Internet network (...via Internet access...Typically, a user...has access to...secure WEB pages)

Regarding claim 15 APA inherently discloses that the first server node is a portal server providing personalized interfaces in hypertext markup language because "a user must connect to the Internet, go to his/her book-marks and select an airline page". Bookmarks and Web pages are known to utilize hypertext markup language. Further resort may be had to U.S. Patent 6,078,907 to Lamm col. 2 lines 13-18 to show that the World Wide Web is a collection of networks linked together using files written in Hypertext Mark-up Language. Thus APA inherently uses and discloses such.

Regarding claim 16 APA clearly sets forth that the data sources require a username and password for access to user bill information in, for example, page 2 lines 20-21.

Regarding claim 17 APA clearly sets forth that the remote computer nodes are personal computers with accessibility to the Internet in, for example, page 2 line 11.

Regarding claims 18 and 19, APA does not explicitly disclose that the remote computer nodes are cellular phones or hand-held computers with accessibility to the Internet, however Kolling sets forth in, for example, col. 12 lines 20-27 that it is known to utilize various forms of communication to access the network including cell phones, Portable Data Assistants (PDA's) (known in the art as hand-held computers) etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize a cell phone with access to the internet and to incorporate such in to APA for the benefit of, for example, allowing bills to be paid from a remote location as such is no more in the use of common and well known methods of accessing the Internet.

Regarding claim 20, APA does not appear to specifically disclose that the second server node stores aggregated bill data on behalf of the user in a connected data repository held externally from the server. Due to the vagueness of this claim as set forth in a section above, the Examiner interprets this claim to mean that the second server, i.e. the bank, is storing aggregated bill data, i.e. the summation of the balance due on the account in a connected data repository, known in the art as a hard drive, external from the server, meaning at some other location. Official notice is taken in that it is old and well known in the

computer server art to have backup hard drives located in remote locations with battery backups for the purpose of ensuring that accounting data is not lost due to power failure, corruption of data, hackers, worms, etc. Accordingly it would have been obvious to one of ordinary skill in the art to apply the teachings of good computer practices to the system set forth in the APA such that a backup copy of the information of an account is stored on a backup hard drive.

Regarding claim 21, APA discloses that the bill-payment software interface is linked to a plurality of secondary interfaces provided in the form of hypertext markup language in, for example, page 3, lines 5-8 "...the fact that they must bookmark many WEB pages in a computer cache". Cache is a memory location storing information, also reads on aggregation of information in one location, and since the bookmarks are for financial web sites related to bill paying then this also reads on aggregated bill data. Bookmarks are hypertext markup language and WEB pages contain hypertext markup language.

Regarding claim 22, APA inherently discloses that the management of the listed bills include at least viewing a full account of the bill, marking that the bill has been paid, deleting the bill, and receiving an alert associated with the bill otherwise the person would not be able to pay the bill because they would not be able to view it. If applicant is of the opinion that APA does not set forth the specifics of this claim then resort may be had to Kolling col. 12 lines 28+ "billers can specify certain data fields as being required and the bill payment system is

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programmed to return payment messages which contain insufficient data"

wherein return payment messages read on the alert.

Regarding claim 23, APA inherently discloses obtaining advice regarding selected treatment of the bill includes system recommendations wherein it is understood that when a person accesses his bills to determine whether payment is required, the date of payment due is a recommendation by the billers system that if payment is not received then late charges, interest rate hikes, etc. may be occurred (system recommendation) and the advice reads on paying the bill.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 13-23 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of prior U.S. Patent No. 6,859,212. This is a double patenting rejection.

Conclusion

13. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although

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the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,141,333 to Chaves, Jr. is cited to show different parts of the Internet and their intercorrelations

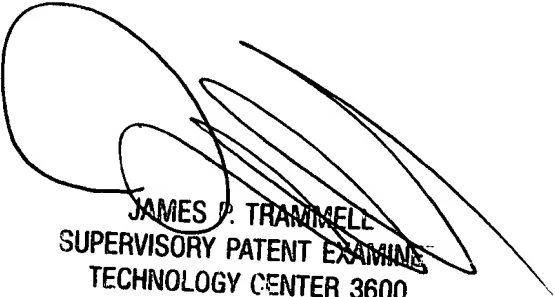
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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